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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,122	07/21/2003	Martyn Gilbert	F0320	8036
<div>48745      7590      11/05/2007</div> <div>SILBER &amp; FRIDMAN 1037 ROUTE 46 EAST SUITE 207 CLIFTON, NJ 07013</div>				
			<div>EXAMINER</div> <div>WASEL, MOHAMED A</div>	
			<div>ART UNIT</div> <div>2154</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>11/05/2007</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/624,122

Applicant(s)

GILBERT ET AL.

Examiner

Mohamed Wasel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

ad

### Response to Amendment

This action is responsive to amendment filed on August 6, 2007. Claims 1-8, 12 and 13 have been amended. Claims 1-8 and 12-14 are presented for examination.

### Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1- 8 and 12-14 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed to a browser program (**software program**), which does not fall within the four statutory classes of 101. Applicant is advised to amend "stored on a computer readable medium..." to read "stored on a computer readable **storage** medium..." to further clarify the claim language and overcome the 101 rejection. Appropriate corrections are required where applicable to overcome the 101 rejections.

Claims 2-8 are rejected under the same rationale as claim 1 due to their dependency.

Claim 12 is rejected under the same rationale as claim 1.

Claims 13 and 14 are rejected under the same rationale as claim 12 due to their dependency.

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7, 8 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Guthrie US Patent No. 6,266,681.

1. As per claim 1, Guthrie teaches a browser program executed on a computer and stored on a computer readable medium (**col. 2 lines 64-67; browser application**) which, when executed by a suitable device, causes the device to carry out method steps of:

examining data received as a page comprising page data and mark up language tags and identifying the mark up language tags (**col. 1 lines 41-59**);

analyzing the identified tags to derive instructions and generating a visual output derived from the page data based on instructions derived from the identified tags (**col. 1 line 60 – col. 2 line 21, abstract**); and

carrying out further operations based on instructions derived from the identified tags and not derived from the page data (**col. 3 lines 30-41**).

2. As per claim 2, Guthrie teaches the browser program executed on a computer and stored on a computer readable medium in which the visual output derived from the page data is suitable for display in a display region of a visual display unit and the further operations define the size of the display region or elements to be displayed on the visual display unit outside or overlaying the display region (**col. 2 lines 11-21**).

3. As per claim 3, Guthrie teaches the browser program executed on a computer and stored on a computer readable medium in which the visual output derived from the page data can be generated by one or more functional sections of the device and the other operations include sending instructions to other functional sections of the device or to other devices (**col. 6 line 41 – col. 7 line 6**).

4. As per claim 4, Guthrie teaches the browser program executed on a computer and stored on a computer readable medium, in which the other operations include the display of text identified by the tags (**col. 1 lines 41-59**).

5. As per claim 5, Guthrie teaches the browser program executed on a computer and stored on a computer readable medium, in which the other operations include the display of text derived from the tags (col. 1 lines 41-59).

6. As per claim 7, Guthrie teaches the browser program executed on a computer and stored on a computer readable medium, in which the other operations include the device requesting and responding to user commands (col. 15 line 51 – col. 16 line 12).

7. As per claim 8, Guthrie teaches the browser program executed on a computer and stored on a computer readable medium, in which the page is a web page suitable for transmission through the Internet (col. 3 lines 18-29, abstract).

8. As per claim 12, Guthrie teaches a markup language tag for use with a browser program executed on a computer and stored on a computer readable medium (col. 2 lines 64-67) adapted to carry out a method including at least steps of examining data received as a page and generating a visual output derived from the page data, said markup language tag (col. 1 lines 41-59) comprising:

said markup language tag being associated with page data to form a page and adapted to cause said browser program to carry out said method (col. 8 lines 18-34; Fig. 6).

9. As per claim 13, Guthrie teaches the markup language tag further comprising a page incorporating the markup language tag, wherein said visual output is based on instructions derived from the identified tag (col. 3 lines 18-29).

10. Claim 14 is rejected under the same rationale as claim 8.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guthrie US Patent No.

6,266,681 in view Thomsen US Patent No. 6,862,596.

11. As per claim 6, Guthrie fails to explicitly disclose a browser program in which the other operations include requesting a smart card reader to carry out a transaction with a smart card

However, Thomsen discloses a browser program in which the other operations include requesting a smart card reader to carry out a transaction with a smart card (col. 4 lines 35-48).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the applicants' invention to combine the teachings of Guthrie and Thomsen because it provides an efficient way of paying for online services through a web page.

#### **Response to Argument(s)**

Applicant's argument(s) filed on August 6, 2007 have been fully considered but they are not persuasive. Therefore, rejection is maintained.

- In the remarks, the Applicant argues in substance that:

Guthrie does not disclose carrying out further operations based on instructions derived from the identified tags and not derived from the page data.

- In response to argument(s):

Examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Guthrie shows a browser having an injection system to properly parse and interpret HTML document such that the injectable component is conditionally generated wherein the browser receives a corresponding HTTP-response from previously designated server, extracts, parses and interprets the HTML document contained within the HTTP-response in order to properly process the HTML document (col. 3 lines 30-41, col. 8 lines 18-34, Fig. 6). In further details, when the browser parses and interprets the code injected by the interceptor code, it conditionally writes the appropriate HTML tags into the HTML document. Assuming that

additional HTML code is written into the document, the browser interprets this HTML code to build an instance (further operations) of the injectable component (col. 15 lines 24-35, Fig. 13 & 14). Claim language is too broad and therefore Guthrie meets the scope of the claimed limitation as currently presented. Applicant is also reminded that prior art of record does not necessary have to have all elements as the claimed invention as long as the prior art of record performs same/similar functionality as the claimed invention. Examiner believes that amendment to the claims to explicitly distinguish the claimed subject matter would clearly define the scope of the claimed invention and possibly overcome art in record.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed Wasel whose telephone number is (571)272-2669. The examiner can normally be reached on Mon-Fri (8:00 am - 5:30 pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MW

October 16, 2007

  
SUPERVISORY PATENT EXAMINER  
NATHAN FLYNN